Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte JOHN E. DAWSON

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Appeal No. 1998-3405
Application No. 08/378,745

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ON BRIEF

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Before THOMAS, HAIRSTON, and DIXON, **Administrative Patent Judges**.

DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 57-88, which are all of the claims pending in this application.

We REVERSE and REMAND.

BACKGROUND

The appellant's invention relates to a system for monitoring loss metrics in a communication network. An understanding of the invention can be derived from a reading of exemplary claim 57, which is reproduced below.

> 57. An apparatus for measuring performance of a port within a communication network having a plurality of ports, said ports for individually interfacing with attached stations or devices, said apparatus comprising:
>
> a first packet detecting circuit operable within said port of said network for detecting a message packet entering said port, said first packet detecting circuit coupled to an input communication stream to said port;
>
> a second packet detecting circuit operable within said port for detecting a message packet exiting said port, said second packet detecting circuit coupled to an output communication stream from said port; and
>
> a counter for maintaining a count value indicating an amount of messages lost or corrupted by said port and indicating an amount of messages lost or corrupted by said network, said counter communicatively coupled to said first packet detecting circuit and communicatively coupled to said second packet detecting circuit.

The (prior) art reference[1] of record relied upon by the examiner in rejecting the appealed claims is:

Dawson 5,390,188 Feb. 14, 1995

Claims 57-88 stand rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-56 of prior U.S. Patent 5,390,188 to Dawson.

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[1] This is the patent issued from the parent application 08/101,390, filed Aug. 2, 1993, from which the present application is a continuation application under 37 CFR 1.60.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 14, mailed Jan. 22, 1998) for the examiner's reasoning in support of the rejections, and to the appellant's brief (Paper No. 13, filed Dec. 15, 1997) and reply brief (Paper No. 15, filed Mar. 27, 1998) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The examiner maintains that claims 57-88 are directed to the same invention as recited in claims 1-56 of the patent. (See answer at page 4.) We disagree with the examiner. We agree with the examiner that the claims at issue are remarkably similar to those claimed in the patent, but they may or may not be of the exact same scope as

recited in the patent. While the examiner maintains that the claims are the same, the examiner has provided no interpretation of the scope of claims in the patent or in the

present application. The examiner maintains that there is no express language required to invoke 35 U.S.C. § 112, sixth paragraph. (See answer at page 4.) We agree with the examiner, but note that the examiner has only generically addressed the changes to the language of the claims. Furthermore, the examiner has not interpreted all the changes in light of the corresponding structure in the specification, and the examiner has not addressed any specific claim limitations which are structural in nature, such as, a counter, memory, comparator, etc. which may preclude the invocation of 35 U.S.C. § 112, sixth paragraph since it recites specific structure and not a functional recitation of a claim limitation. Here, the examiner has made no findings/evaluation concerning the appropriate claim interpretation in the present prosecution history, and the prosecution history of the parent prosecution history to the Dawson patent is completely silent with respect to claim interpretation under 35 U.S.C. § 112, sixth paragraph. (See MPEP 2181 et seq. for a discussion of 35 U.S.C. § 112,
sixth paragraph.) Therefore, we must reverse the rejection under 35 U.S.C. § 101

based on double patenting since the claims are not ***per se*** directed to the same invention as recited by the express language of the claims.

We make no finding concerning the appropriateness of a rejection based upon obvious-type double patenting since there is no evaluation concerning appropriate claim interpretation at this time. Therefore, we remand the application to make the appropriate findings concerning the scope of the claims in both the patent and the claims at issue and to consider the appropriateness of a rejection under obvious-type double patenting.

CONCLUSION

To summarize, the decision of the examiner to reject claims 57-88 under 35 U.S.C. § 101 is reversed, and the application is remanded to the examiner to make claim interpretations concerning the scope of the claims and to consider a rejection under the judicially created doctrine of obvious-type double patenting.

This application, by virtue of its “special” status, requires an immediate action. MPEP § 708.01(D)(Rev. 1, Feb. 2000)**.**

REVERSED and REMANDED

JAMES D. THOMAS Administrative Patent Judge	)
KENNETH W. HAIRSTON Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
JOSEPH L. DIXON Administrative Patent Judge	)

jld/vsh

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